

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Steven A. Bogen and Herbert H. Loeffler

Application No.: 10/823,368 Group: 1797

Filed: April 12, 2004 Examiner: L. Alexander

Confirmation No.: 4846

For: SLIDE STAINER WITH HEATING

REPLY BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted pursuant to the Examiner's Answer mailed from the U.S. PTO on December 5, 2008.

STATUS OF CLAIMS

Claims 1, 3, 5-8, 10 and 12-18 have been finally rejected. Claims 2, 4, 9 and 11 were canceled. Claims 1, 3, 5-8, 10 and 12-18 are on appeal.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 3, 5-8, 10 and 12-18 are properly rejected under 35 U.S.C. § 103(a) as being obvious over Heidt (US 5,089,229) (“Heidt”), or Kerr (US 5,075,079) (“Kerr”), each in view of Potter (US 5,819,842) (“Potter”). In the December 5, 2008 Examiner’s Answer, the Office vacated the rejection with respect to Copeland (US 5,654,200) and Rogers (US 4,043,292) in the interest of reducing the issues for consideration.

Appellants note that no new grounds of rejection were set forth in the Examiner’s Answer.

ARGUMENTS

All arguments presented in the Appeal Brief are maintained.

Consideration of Declaration of Ron Zeheb, Ph.D., Under 37 C.F.R. § 1.132

On page 5 of the Examiner's Answer, the Examiner stated that “[t]he 9/23/08 1.132 Declaration has not been submitted in a timely manner and has not been considered.” The only 1.132 Declaration filed in this application is the Declaration of Ron Zeheb, Ph.D., which was filed, along with a Request for Continued Examination and Amendment, on October 31, 2007. (The Declaration included as evidence with the Appeal Brief was a copy of the Declaration filed on October 31, 2007.) In response to the Request for Continued Examination and Amendment, the Examiner issued a Final Office Action that made specific arguments based on the content of the Declaration. Accordingly, it is respectfully submitted that the Declaration of Ron Zeheb, Ph.D. Under 1.132 was timely filed and should be considered.

Rejection of Claims 1,3, 5-8, 10 and 12-18 Under 35 U.S.C. § 103(a)

Claims 1, 3, 5-8, 10 and 12-18 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Heidt or Kerr in view of Potter.

In the Examiner's Answer, the Office maintains that the primary references, Heidt and Kerr teach every element of the claimed invention except “plural temperature sensors on the platform for sensing temperature of respective heated surface areas.” The Office is relying on Potter for this teaching.

As discussed in great detail in Applicants' Appeal Brief, in addition to failing to teach “plural temperature sensors on the platform for sensing temperature of respective heated surface areas,” neither Heidt nor Kerr relates to microscope slides or microscope slide staining. Instead, each is directed to an apparatus used in the analysis of blood in which a drop of serum is dispensed onto a chemically reactive analyte slide.

Potter also fails to disclose a microscope slide bearing a biological sample as claimed. Page 5 of the Examiner's Answer states that “Potter et al. has been properly cited as a secondary reference teaching that it is known to independently heat slides and the heating of samples in a well is not at issue.” However, Potter only teaches heating samples in a well; it does not teach heated surface areas, each heated by an electric heater thereunder, each heated surface area being

adapted to be in contact with and underlie a microscope slide bearing a biological sample, as claimed. As the Court of Customs and Patent Appeals stated “[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Herman Wesslau*, 353 F.2d 238, 241 (CCPA 1965). In this case, the Examiner has improperly disregarded the purpose for which the invention of Potter was designed, namely an apparatus for use in enzyme reactions, hybridization and melting of nucleic acids, and thermal cycling. The Potter reference never uses the word slide; instead, it consistently uses “sample container” or “well.” Potter discloses an apparatus for use in laboratory techniques that are incompatible with a microscope slide. One of ordinary skill in the art would not perform an enzyme reaction, hybrization reaction or thermal cycling on a microscope slide.

Thus, Claims 1, 3, 5-8, 10 and 12-18 meet the requirements of 35 U.S.C. § 103(a) in view of either Heidt or Kerr, alone, or in any combination with Potter.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By /James M. Smith, Reg. No. 28,043/

James M. Smith

Registration No.: 28,043

Telephone: (978) 341-0036

Faxsimile: (978) 341-0136

Concord, MA 01742-9133

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